In addition, each of the pending claims was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of Sees in view of Russ. Applicant respectfully traverses this rejection.

In determining whether a non-statutory basis exists for a double patenting rejection, the first question to be asked is – does any claim in the application define an invention that is merely an obvious variation of the invention claimed in the patent? MPEP 804. In this case, the answer to this question is no, and therefore a double patenting rejection is not appropriate.

For example, claim 1 of the present application recites a method of mapping a topology of a spare capacity of a telecommunications network. This method includes steps such as outputting a message from each spare link, identifying port numbers, storing as data the respective port numbers, and generating from the stored data the topology of the spare links interconnecting the nodes of the network.

The claimed subject matter the present application is simply not obvious over what is claimed in the Sees patent. For example, claim 1 of the Sees patent is directed to a method of automatically reconfiguring a network to the topology it had before a working link failed. Each of the other claims is directed toward similar subject matter. The Examiner has provided no rationale as to how the presently pending claims are obvious over these claims.

In the office action, the Examiner states that the Sees patent discloses all the claimed subject matter, except for certain elements that are alleged to be taught or suggested by Russ. Applicant respectfully submits that it is not relevant what is disclosed by the Sees patent, only what is claimed. As laid out in Section 804 of the MPEP, any obviousness-type double patenting rejection should make clear: a) differences between the inventions defined by the conflicting claims - *a claim* in the patent compared to *a claim* in the application; and b) the reasons why a

person of ordinary skill in the art would conclude that the invention defined *in the claim* in issue is an obvious variation of the invention defined *in the claim* of the patent.

Applicant respectfully submits that the claims in the pending application are not obvious over the claims in the issued patents and therefore requests that the double patenting rejection be withdrawn.

In view of the above, Applicants respectfully submit that the presently pending application is in condition for allowance. If the Examiner should have any questions or feel that a discussion would advance the prosecution, the Applicants invite the Examiner to contact the Applicants' attorney at the telephone number and address listed below.

Respectfully submitted,

1/22/03
Date

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Bengston, *et al.* Attorney Docket No.: RIC-99-030

Application No.: 09/365,081 Group Art Unit: 2664

Filed: 7/30/1999 Examiner: Shah, Chirag G.

Title: Method for Monitoring Spare Capacity of a DRA Network

Commissioner for Patents
Washington, D.C. 20231

STATEMENT OF COMMON OWNERSHIP

Dear Sirs:

The undersigned is an attorney of record on the above-referenced patent application.

U.S. Application Serial No. 09/365,081 and U. S. Patent Nos. 6,222,821 and 5,623, 481 were, at the time the invention of Application 09/365,081 was made, entirely owned by, or subject to an obligation of assignment to, the same organization.

Respectfully submitted,

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Reg. No. 40,289